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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,149	08/08/2001	Manoj Abraham	020431.0770	3112

7590 02/14/2005

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EXAMINER

FISCHETTI, JOSEPH A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/925,149

Applicant(s)

MANOJ

Examiner

Joseph A. Fischetti

Art Unit

3627

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 17-24.
Claim(s) withdrawn from consideration: 1-16,25 and 26.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the restriction is improper. However, the examiner maintains that the evidence of separate and distinctness made in the last office action more than adequately suffices to sustain the restriction and is fully compliant with MPEP requirements for showing separate and distinctness. There is clear serious burden for exactly the reasons set forth in the Final Office Action and who better to assess this burden than the person who is charged with conducting the examination. Again, this is a 705 business application and the burdens upon the examiners in this class rise exponentially with the independent claims required for examination. For example, unlike the rest of the Office, in the event of allowance, a separate reason for allowance must be made for each and every independent claim allowed and reiterative analyses made for each such independent claim relative the best NPL reference, foreign and US art. Hence, serious burden is placed upon the examiner whenever an additional statutory class of invention is imposed for examination on the examiner.

The invention of groups II, III are related as subcombinations as evidenced in that office action. Base claim 17 recites that the logic is encoded on a media. As such, the only physical article of manufacture present in the claim is the media. The media is considered to be a subcombination vis. a vis. the system of claim 9, as would be a speaker to a stereo system. The media has clear limitations in its capacity relative to the system, it cannot process information as does the system, nor can it write new logic to the media. Hence the scope of claims will differ because of these inherent limitations. Applicant wrongly argues that "Inventions II and III "are not separately usable". In direct contradiction to this, the Examiner cites to read write media such as a CD which is fully capable of being taken away from the system and used elsewhere.

Applicant attempts to dilute the restriction by maintaining that the inventions are obvious over each other. However, there is no requirement for the Examiner to withdraw the restriction one this statement is made; the MPEP only recites "should" rather than shall. Such a statement is only good contemporaneously with the last condition of the claims and it does not prevent the applicant from amending to overcome obviousness. Hence the Examiner seeks to protect himself from such a tactic.

Regarding the rejection based on Section 103, applicant is focusing on times in the product network in which to make distinction. His arguments are clearer than what is recited in the claims. The Examiner has provided a motivation in the Office Action, and has satisfied his obligation under Section 103.

Regarding the Official Notice taken, the Examiner has fulfilled his responsibilities to the Applicant by providing the Stilp reference.

AM A JS
Primary Examiner
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